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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/010,779

12/03/2001

Jonathan Eisenstein

G06.003

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28062

7590

04/11/2006

BUCKLEY, MASCHOFF, TALWALKAR LLC
5 ELM STREET
NEW CANAAN, CT 06840

EXAMINER

NGUYEN, TAN D

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,779

Applicant(s)

EISENSTEIN, JONATHAN

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ✓ 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ✓ 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/03/01

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The IDS filed 12/2001 has been reviewed and recorded.

Claim Status

Claims 1-42 are active and are rejected as followed.

Claim Objections

1. Dependent claims 4-7, 10, and 15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

(1) Independent method claim 1 calls for "(b) transmitting an electronic mail message..". Dep. claims 4-5, 6-7 does not further limit the "transmitting" step since it deals with an option of carrying step (b) only if it meets a certain condition which do not further limit step (b) of claim 1 which positively states that step of "transmitting" must be carried out.

(2) As for dep. claim 10, it's not clear how this step further limits the step of "transmitting the message".

(3) It's not clear how this step "specifying a connection to the server" further limits claim 1 which have nothing to do with the server.

Claim Rejections - 35 USC § 112

2. Claim 16 recites the limitation "the event" in line 1. There is insufficient antecedent basis for this limitation in the claim 13.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness (unexpected results).

6. **Claims 1, 11, 12, 13-16, 17, 18-19, 20, 21-23, 24-30, 31-36, and 37-42 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over IMMEL (US 2002/0010636).**

As for independent method^{1/4} claim 1, which deals with a method for inviting a response from a respondent, comprising the steps of:

- (a) receiving an information (indication) that a transaction has been completed/closed {see [0016 "a reported transaction ... sending of a survey to the buyer, seller or both"], [0060 "completed"], [0062 "a closed transaction"]};
- (b) transmitting a message, electronic mail, to a respondent, and the message including one or more questions concerning the transaction {[0036, "*electronic mail message*"], [0060 "*survey upon ... completed*"], [0062]}.

Alternatively, the use of well known surveying format parameters, the type of questions, which depend on the type of transaction, degree of specific, format, etc., is within the skill of the artisan and would have been obvious to implement any type of survey format.

As for independent product claim 11, which is the computer-readable medium storing processor-executable process steps of claim 1 above, it's rejected over the computer-readable medium to carry out the method claim of IMMEL for the rejection of claim 1 above.

As for independent system claim 12, which is the system to carry out the process steps of claim 1 above, it's rejected over the system of IMMEL to carry out the rejection of claim 1 above, see also Fig. 5. The 1st device is (502), (514), (504) and the 2nd device is (508), 512.

As for Independent method^{2/4} claim 13, which has similar limitation as in claim 1 and wherein the preamble includes the limitation of “a survey”, this is taught in IMMEL [0016, 0060, 0061].

As for dep. claim 14 (part of 13 above), which deals with well known surveying parameters, i.e. receiving a response, this is inherently included or fairly taught in [0016, 0060, 0061]}.

As for dep. claim 15 (part of 13 above), which deals with well known electronic mail server, this is inherently included or fairly taught in [0036] or Fig. 1 (502), (516).

As for dep. claim 16 (part of 13 above), which deals with the type of indication, i.e. querying the database for information populating the defined fields, this is fairly taught in [0016].

As for independent product claim 17, which is the computer-readable medium storing processor-executable process steps of claim 13 above, it's rejected over the computer-readable medium to carry out the method claim of IMMEL for the rejection of claim 1 above.

As for Independent method^{3/4} claim 18, which has similar limitation as in claim 1 and wherein the preamble includes the limitation of “producing a survey results”, this is taught in IMMEL [0016, 0060, 0061].

As for dep. claim 19 (part of 18 above), which deals with well known surveying parameters, the type or feature of the question, i.e. questions that were transmitted by a first device, etc. this is inherently included or fairly taught in [Fig. 1, 0016, 0060, 0062].

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Note that the use of passive voice, i.e. were transmitted from, carries little patentable weight in a method claim since it's not clear how it further limits a question. Does this limitation adds more to the features of the question like the type of question? If the applicant wants to add more patentable weight to the feature, changing the claim language to active voice, i.e. "transmitting the questions using a first device .." is recommended.

As for independent product claim 20, which is the computer-readable medium storing processor-executable process steps of claim 18 above, it's rejected over the computer-readable medium to carry out the method claim of IMMEL for the rejection of claim 18 above.

As for independent system claim 21, which is the system to carry out the process steps of claim 18 above, it's rejected over the system of IMMEL to carry out the rejection of claim 18 above, see also Fig. 5. The client device is (502), (514), (504) and the server device is (508), 512.

As for dep. claim 22, (part of 21 above), which deals with well known surveying parameters, the type or feature of the question, i.e. question that is transmitted according to a schedule, this is inherently included or fairly taught in [0016, 0060, 0062] which teaches the occasions/events when the survey is carried out. Note that the use of passive voice, i.e. is transmitted from, carries little patentable weight in a method claim since it's not clear how it further limits a question. Does this limitation adds more to the features of the question like the type of question? If the applicant wants to add

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more patentable weight to the feature, changing the claim language to active voice, i.e. "transmitting the questions using a predefined transmission schedule" is recommended.

As for dep. claim 23, (part of 21 above), which has similar limitation as in dep. claim 14 above, it's rejected for the same reason set forth in the rejection of dep. claim 14 above.

As for Independent method^{4/4} claim 24, which has similar limitation as in claim 13 above and wherein the "criteria have been satisfied" reads over "closed/completed status for the transaction", it's rejected for the same reasons set forth in claim 13 above.

As for dep. claims 25, 28, (part of 24 above), which deals with the type of indication, i.e. has been closed (or completed), this is rejected for the same reason set forth in step (b) above.

As for dep. claims 26, 27, 29-30, (part of 24 above), which have similar limitations as in dep. claims 14-16 (part of 13 above), they are rejected for the same reasons set forth in the rejections of dep. claims 14-16 above.

As for Independent product claim 31, which is the computer-readable medium storing processor-executable process steps of claim 24 above, it's rejected over the computer-readable medium to carry out the method claim of IMMEL for the rejection of independent method claim 24 above.

As for dep. claims 32-36 (part of 31 above), which have similar limitations as in dep. claims 25-31 (part of 24 above) respectively, they are rejected for the same reasons set forth in the rejections of dep. claims 25-31 above.

As for Independent system claim 37, which is the system to carry out the process steps of claim 24 above, it's rejected over the system of IMMEL to carry out the rejection of claim 24 above, see also Fig. 5.

As for dep. claims 38-42 (part of 37 above), which have similar limitations as in dep. claims 25-31 (part of 24 above) respectively, they are rejected for the same reasons set forth in the rejections of dep. claims 25-31 above.

7. Dependent claims 2-3, 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over IMMEL.

As for dep. claim 2 (part of 1 above), which deals with well known surveying parameters, the type of transaction or well known transaction parameters, i.e. type such as help desk transaction, the selection of the type of transaction is not critical the claimed invention and would have been obvious to apply to any type of transaction as mere using other similar type of business transaction in the similar method to achieve similar results, absent evidence of unexpected results.

As for dep. claim 3 (part of 1 above), which deals with the type of indication, i.e. has been closed (or completed), this is rejected for the same reason set forth in step (b) above.

As for dep. claim 8 (part of 1 above), which deals with the type of indication, i.e. has been closed (or completed), this is rejected for the same reason set forth in step (b) of claim 1 above.

As for dep. claim 9 (part of 1 above), which deals with well known surveying parameters, the type or feature of the question, i.e. question that is transmitted

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according to a schedule, this is inherently included or fairly taught in [0016, 0060, 0062] which teaches the occasions/events when the survey is carried out. Note that the use of passive voice, i.e. is transmitted from, carries little patentable weight in a method claim since it's not clear how it further limits a question. Does this limitation adds more to the features of the question like the type of question? If the applicant wants to add more patentable weight to the feature, changing the claim language to active voice, i.e. "transmitting the questions using a predefined transmission schedule" is recommended.

As for dep. claim 10 (part of 1 above), which deals with well known surveying parameters, i.e. receiving a command from a user to transmit the question, this is inherently included or fairly taught in [0016, 0060, 0061]}.

8. Dependent claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over IMMEL in view of RILEY et al (US 2002/0123983) or vice versa.

As for dep. claim 2 (part of 1 above), the teachings of IMMEL is cited above. RILEY et al discloses a method for implementing service /business/deal of help desk capability and managing the service/business deal by conducting interview or survey after the service {see 0061, 0005, 0006}. It would have been obvious to modify the teachings of IMMEL by applying the same survey on other similar business transaction (or deal or service) such as help desk service as taught by RILEY et al as mere applying the same steps to similar business service/deal/transaction to achieve similar results, absent evidence of unexpected results.

Vice versa, it would have been obvious to modify the teachings of RILEY et al by conducting the survey after an indication that the transaction has been completed as taught by IMMEL above.

As for dep. claim 3 (part of 1 above), which deals with the type of indication, i.e. has been closed (or completed), this is rejected for the same reason set forth in step (b) above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US 2001/0029470 is cited to teach the sending of a survey at the completion of a transaction, see Fig. 9, similar to the teachings of IMMEL above. It's cited for applicant's awareness of potential use in the future if needed to avoid duplicate or multiple rejections.

2) US 2001/0037206 is cited to teach method and system for automatically generating questions and receiving customer feedback for each transaction.

No claims are allowed.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
April 10, 2006


DEAN T. NGUYEN
PRIMARY EXAMINER